

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1-20 are now pending in this application, new claims 19 and 20 having been added by the present Amendment. Claims 1-18 stand rejected.

Changes to the Drawings

The drawings were objected to because in Fig. 3 “result” and “user” are spelled incorrectly in Step S16. Fig. 3 has been amended to correct the misspellings in Step S16. Further, “Ethernet” in Step S14 of Fig. 3 has been changed to “Internet.” This change is consistent with page 13, line 27-page 14, line 3 of the present application, which indicates that print contents are sent to a printer by way of the Internet 9.

Approval and entry of the changes to the drawings are respectfully requested.

Objections to the Specification

The specification was objected to for informalities. Specifically, the specification was objected to because page 10, line 3 teaches that the “desktop personal computers 1-3, 1-4 having a GPS (Global Positioning System) 10” while in Fig. 1, only the PDA has GPS 10.

The specification has been amended to clarify that the mobile equipment 1-2 includes GPS 10, and that the cellular telephone 1-1 may also include GPS 10. This change is consistent with the present application, e.g., page 11, lines 4-7 and lines 16-18, which describe that the cellular telephone 1-1 as well as the PDA 1-2 may include GPS.

Amendment under 37 C.F.R. §1.111
Serial No. **09/822,228**
Attorney Docket No. **010273**

AMENDMENTS TO THE DRAWINGS:

Please amend Fig. 3 in accordance with the attached replacement sheet.

Approval and entry of the changes to the specification are respectfully requested.

Rejections under 35 U.S.C. §102

Claims 1, 3-6, 10, and 12 are rejected under 35 U.S.C. §102(e) as being anticipated by **Eldridge et al.** (USP 6,421,716).

Rejections under 35 U.S.C. §103

Claims 11 and 2 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Eldridge** in view of **Johnstone et al.** (USP 5,898,680). Claims 16, 17, 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Eldridge** in view of **Kawai et al.** (USP 6,404,994). Claims 18 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Eldridge** in view of **Maruta et al.** (USP 6,516,157).

For the reasons set forth in detail below, these rejections, to the extent they are considered to apply to the amended claims, are respectfully traversed.

The **Eldridge et al.** reference discloses a user interface facility for users of mobile computing devices that provides fast and easy access to local document services (e.g., print, scan, fax). More specifically, according to **Eldridge et al.**, the user interface that is presented to a user of a mobile computing device provides access to document services that are ordered by proximity to the physical location of the user. The closest document service is made immediately available

to the user and less proximate document services made accessible by navigating through a hierarchically ordered list of document services (see, e.g., “Summary” in column 13, lines 51 – 59).

The **Eldridge et al.** system uses token-enabled mobile computing devices 118 capable of browsing through a user’s documents stored on wire-based networks 116 (intranet) or 122 (Internet) (see column 3, lines 58 – 64). The document tokens may reference documents on any standard web server operating on intranet 116 or Internet 122 (see column 4, lines 62 – 64). As shown in Fig. 1, transmissions from a mobile computing device 118 are routed through one of gateways 114 or 120 to a transaction server 144 that manages transaction requests for document services available on intranet 116 or Internet 122 (see column 4, lines 24 – 29).

The various document services available according to **Eldridge et al.** include *print*, scan and fax services (see, e.g., column 8, line 41). A user of the mobile computing device is able to request document services based on their function (e.g., printing) and the physical location of the user (see, e.g., col. 6, line 61 – col. 7, line 10).

Eldridge et al. discloses embodiments wherein the mobile computing device 118 communicates with networks using infrared (IR) or radio frequency (RF) transceivers (see Figs. 2 and 3; column 3, lines 36-49). More particularly, Fig. 3 illustrates an embodiment wherein “contextual information” (i.e., location) of the mobile computing device is obtained through GPS

Amendment under 37 C.F.R. §1.111
Serial No. 09/822,228
Attorney Docket No. 010273

or through positioning systems available in cell phones and communicated directly to a server 126 through an RF communications system (column 6, lines 52 – 60). Further, note that instead of using a mobile computing device, **Eldridge** teaches that any user interface coupled to the wire-based network can be used, such as a web browser (see column 14, lines 6-13).

Eldridge et al. teaches a “context identifier” that can represent a physical location of the mobile computing device and is used to reference an entry in a database. The entry in the database may include information about the location and function of a physical device (e.g., a printer) (see column 8, lines 46 – 49 and 58 – 65; column 9, lines 43 – 46).

In operation of the print service, upon receipt of a request for available services, a directory server 142 provides a list of available document services reflecting location information. This information is transmitted to the mobile computing devices 118 as a list of services received by the mobile computing device 118. The list of services includes a specific device (e.g, printer) as well as other devices proximate (i.e., close) to the specific device. (see, e.g., column 8, line 65 – column 10, line 37).

Patentability Arguments

Claims 1 and 10 have been amended to clarify that the location information and database include more extensive information than the database disclosed by **Eldridge et al.** For example, as disclosed on page 12, line 9 through page 13, line 5 and page 11, lines 5-18 and page 18, lines

Amendment under 37 C.F.R. §1.111
Serial No. **09/822,228**
Attorney Docket No. **010273**

4-5 of the present application, the map database 3 includes zip codes, telephone numbers, and mobile communication device base station longitude and latitude information to identify the client base station. In contrast, **Eldridge et al.** discloses a database that stores a “context identifier” representing a physical location of the mobile computing device, but does not go into further detail.

The Johnstone et al. reference

The Examiner recognizes that **Eldridge et al.** do not disclose the features recited in claims 2 and 11 and applies **Johnstone et al.** to teach the features recited in claims 2 and 11.

Johnstone et al. discloses a system for providing a digital map to a user based on GPS data. More particularly, according to **Johnstone et al.**, a user terminal 22 includes a broadcast receiver for receiving digital maps from a satellite based digital broadcast system. The user terminal 22 is also equipped with GPS for determining a geographic position of the user. The user may receive general data including a digital map covering a wide geographic area and a map covering a portion of the geographic area where the user is located.

It is respectfully submitted that **Johnstone et al.** do not alleviate the deficiencies of **Eldridge et al.** Specifically, claims 2 and 11 are directed a method and apparatus, respectively, for sending map information showing the nearest printing agent printer site based on location information from a client terminal.

Johnstone et al. discloses a user receiving a general map covering a wide geographic area and a map covering a portion of the geographic area where the user is located. **Johnstone et al.** do not disclose or suggest obtaining a map showing a specific location (i.e., a nearest printer agent site).

The Kawai et al. reference

The Examiner applies **Kawai et al.** to reject claims 7, 8, 16 and 17. **Kawai et al.** disclose a copying machine having a charging device 12 that controls a usage charge of the copying machine. The charging device 12 may use an information memory medium, such as a prepaid card, on which monetary information is recorded (column 5, lines 15 – 20).

Kawai et al. also teach that an advertisement may be added to a document, and that a second charging device is provided for charging the advertiser (see column 5, lines 20 - 29). **Kawai et al.** disclose that separate fees are charged to each of the user and the advertiser (see, e.g., column 6, lines 26-28 and column 7, line 66 – column 8, line 2).

With respect to claims 8 and 17, the Examiner asserts that **Kawai et al.** disclose discounting a printing fee in accordance with agent printing that includes an advertisement. However, unlike the claimed invention, **Kawai et al.** disclose that separate fees are charged to

Amendment under 37 C.F.R. §1.111
Serial No. 09/822,228
Attorney Docket No. 010273

the user and the advertiser, but do not disclose that the user's fees are discounted in accordance with advertisements included in the copies.

The Maruta et al. reference

The Examiner applies **Maruta et al.** to reject claims 9 and 18. Claims 9 and 18 call for *sending an agent printing fee to said client terminal in accordance with said agent printing results.*

Maruta et al. disclose a printing system that calculates printing cost using data input via a remote data input terminal and returns calculated printing cost to the remote data input terminal. However, in contrast to the present invention, **Murata et al.** is directed to a system for calculating print costs prior to a print job so that the job can be modified, if desired, to reduce costs. The invention recited in claims 9 and 18 sends a printing fee in accordance with printing results.

In view of the above amendments and remarks, it is respectfully submitted that all pending claims distinguish over the prior art. Reconsideration and withdrawal of the rejections under §102 and §103 are respectfully requested.

New Claims

New claims 19 and 20 have been added by the present Amendment. New claim 19 combines the features of original claims 1 and 6. New claim 20 combines the features of original claims 10 and 15. Claims 19 and 20 call for *"receiving a user ID from said client terminal, and*

Amendment under 37 C.F.R. §1.111
Serial No. **09/822,228**
Attorney Docket No. **010273**

sending to said client terminal the printing agent printer site selected in the past by the user indicated by said user ID. The Examiner asserts in the rejections of claims 6 and 15 that “the idea of sending a list based on past selections is inherent to the system of Eldridge in that it is an advanced printing system and therefore includes the ability to set a default printer [one that the user has used before]” (see Office Action, page 5, lines 9 – 11).

First, contrary to the Examiner’s assertion, claims 6 and 15 are not related to setting a default printer. Setting a default printer involves a user actually selecting programmatically any of various printers connected to the computer to act as a default printer that will automatically print when the user prints a document. In contrast, claims 6 and 15 call for sending a printer agent printing site to a user based on past use. The user does not have to select a printer to act as a default printer.

Secondly, the Examiner asserts that the features of claims 6 and 15 are inherent. By asserting that the features of claims 6 and 15 are inherent, the Examiner admits they are not explicitly disclosed in the reference. Inherent anticipation requires that the missing descriptive material is *necessarily* present in the prior art, not merely probably or possibly present in the prior art. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d, 1949, 1950-51 (Fed. Cir. 1999). Regarding inherency, MPEP 2163 II(ii)(b) states:

Amendment under 37 C.F.R. §1.111
Serial No. **09/822,228**
Attorney Docket No. **010273**

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

It is submitted that the features of claims 6 and 15 are not **necessarily** present in the **Eldridge et al.** reference. For example, as noted above, setting a default printer is usually accomplished by the user programming which printer is to act as the default. Therefore, because there is at least one other way a printer agent could be selected, the system of **Eldridge et al.** does not *necessarily* include the features of claims 6 and 15.

Accordingly, new claims 19 and 20, which include the features of claims 6 and 15, respectively, patentably distinguish over the cited prior art.

CONCLUSION

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants’ undersigned attorney to arrange for an interview to expedite the disposition of this case.

Amendment under 37 C.F.R. §1.111
Serial No. **09/822,228**
Attorney Docket No. **010273**

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



William M. Schertler
Attorney for Applicants
Registration No. 35,348
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

WMS/ns/lde
Enclosures: Replacement Figure 3